

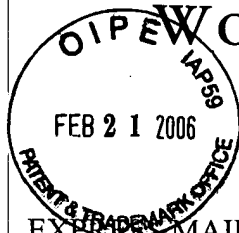
RICK D. NYDEGGER
BRENT P. LORIMER
THOMAS R. VUKSINICK
LARRY R. LAYCOCK
JONATHAN W. RICHARDS
DAVID R. WRIGHT
JOHN C. STRINGHAM
JOHN M. GUYNN
CHARLES L. ROBERTS
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RICHARD C. GILMORE *
STERLING A. BRENNAN
R. BURNS ISRAELSEN
DAVID R. TODD
DAVID B. DELLENBACH
L. DAVID GRIFFIN
ADRIAN J. LEE
FRASER D. ROY
CARL T. REED



R. PARRISH FREEMAN, JR.
PETER F. MALEN, JR.
L. REX SEARS, PH.D.
WILLIAM R. RICHTER
ROBERT E. AYCOCK
JENS C. JENKINS
MICHAEL B. DODD
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BRETT I. JOHNSON
MATTHEW A. BARLOW
WESLEY C. ROSANDER
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JOSEPH G. PIA
CLINTON E. DUKE
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JAMES B. BELSHE
KIRK R. HARRIS
MICHAEL M. BALLARD
DAVID A. JONES
SHANE K. JENSEN
JONATHAN M. BENNS, PH.D.
SCOTT A. WOODBURY
JOHN T. GADD
MARK W. FORD
AARON M. SMITH

VERNON R. RICE §
OF COUNSEL

* Admitted only in California
§ Admitted only in Virginia



02/22/06
WORKMAN | NYDEGGER
INTELLECTUAL PROPERTY ATTORNEYS

AF \$ 22W
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UTAH 84111
TELEPHONE: (801) 533-9800
FAX: (801) 328-1707
WEBSITE: HTTP://WWW.WNLAW.COM

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PATENT APPLICATION
Docket No. 14531.71.4.3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)
John J. Daniels)
Serial No. 09/993,780) Art Unit
Filed: November 16, 2001) 2613
For: REMOTELY CONTROLLING A VIDEO RECORDER)
Examiner: Y. Young Lee)

Mail Stop APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

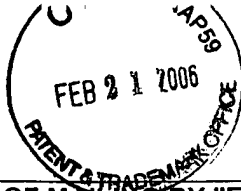
Transmitted herewith are the following for entry in the above-identified application:

- Appeal Brief and Appendix (each in triplicate)
- X Enclosed with this transmittal is a Form PTO-2038 in the amount of \$500.00 for filing brief in support of appeal.
- X The Commissioner is hereby authorized to charge payment of any other fees associated with this communication or credit any overpayment to Deposit Account No. 23-3178. Duplicate copies of this sheet are attached.

Dated this 21st day of February, 2006.

Respectfully submitted,

DAVID R. TODD
Registration No. 41,348
Attorney for Applicant
Customer No. 047973
(801) 533-9800



CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)			Docket No. 14531.71.4.3	
Applicant(s): John J. Daniels				
Serial No. 09/993,780	Filing Date November 16, 2001	Confirmation No. 1576	Examiner Y. Young Lee	Group Art Unit 2613

Invention: REMOTELY CONTROLLING A VIDEO RECORDER

I hereby certify that the Transmittal letter (1 page); Appeal Brief (39 pgs) (in triplicate); PTO Form 2038 in the amount of \$500.00; and postcard are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 21, 2006.

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PATENT APPLICATION

Docket No. 14531.71.4.3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND
INTERFERENCES

In re application of:

John J. Daniels

Serial No.: 09/993,780

Filed: November 16, 2001

For: REMOTELY CONTROLLING A VIDEO RECORDER

Examiner: Y. Young Lee

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BRIEF OF APPELLANT

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

On December 19, 2005, Appellant timely filed a Notice of Appeal from the action of the Examiner in finally rejecting all of the pending claims in this application. This appeal brief is being filed under the provisions of 37 C.F.R. § 41.37. The filing fee of \$500.00, as set forth in 37 C.F.R. § 41.20(b)(2), is submitted herewith. This brief is being filed on February 21, 2006 and is therefore timely under 37 C.F.R. § 41.37(a)(1) and 35 U.S.C. § 21(b).

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REAL PARTY IN INTEREST

The real party in interest is Microsoft Corporation.

RELATED APPEALS AND INTERFERENCES

The present application claims priority to application serial no. 08/306,642 and to application serial no. 08/038,240. The appeal from the present application is “related to” pending Appeal No. 2006-0604 in the sense that Appeal No. 2006-0604 is an appeal from an application which *also* claims priority to application serial no. 08/306,642 and to application serial no. 08/038,240. The subject matter at issue in the two appeals, however, is different, and the appeals are unlikely to affect or be affected by one another. Appeal No. 2006-0604 is currently pending, and no decision has yet been issued in that appeal.

STATUS OF CLAIMS

The application was originally filed with claims 1-36. Claims 37-78 were added by amendment. Claims 1-2, 9-12, 16-26, and 31-36 have been cancelled. Counsel for the Appellant made a telephonic request for an Examiner’s Amendment to cancel claim 77 on December 19, 2005, and submitted a Supplemental Amendment “H” pursuant to 37 C.F.R. § 41.33 on February 17, 2006 to cancel claims 42, 48, and 77 and to present some of the claims in better form for consideration on appeal, but none of these amendments has yet been entered. Claims 3-8, 13-15, 27-30, 37-76, and 78 are appealed in the present application.¹

¹If Supplemental Amendment “H” is entered, then claims 42 and 48 need not be considered, because they have been cancelled in that Amendment.

STATUS OF AMENDMENTS

Counsel for the Appellant made a telephonic request for an Examiner's Amendment to cancel claim 77 on December 19, 2005, and submitted a Supplemental Amendment "H" pursuant to 37 C.F.R. § 41.33 on February 17, 2006 to cancel claim 77 and to present some of the claims in better form for consideration on appeal, but none of these amendments has yet been entered.

SUMMARY OF CLAIMED SUBJECT MATTER

The appealed claims are directed to methods and products for remotely controlling a video recorder. Recording instructions are provided to a recording device *from a server* and *in response to* the selection of a television program from a programming schedule.

There are four independent claims: claims 37, 44, 50, and 58. Claim 37 presents the invention from the point of view of the server that provides the recording instructions. Claim 44 presents the invention from the point of view of the client(s) that interact with the server. Claims 58 and 50 are intended to be computer-program-product claims requiring computer readable media having instructions for performing the methods in claims 37 and 44, respectively. The subject matter of claims 44 and 50 will first be described:

Claim 44 reads as follows:

44. In an interactive television system that includes a computing system and a recording device that is configured to record television programs, and wherein the interactive television system is connectable by means of the computing system to a server that is connectable to a network, a method for enabling the server to control the recording of one or more selected television programs by the interactive television system, the method comprising the acts of:

- sending, from the computing system, a request to the server for a program schedule that identifies television programs that can be received by the interactive television system;
- receiving, at the computing system, the program schedule from the server;
- displaying, at the computing system, the program schedule after it is received from the server;

receiving, at the computing system, a user selection of one or more television programs from the program schedule;

sending, from the computing system, a request to the remote server for the selected one or more television programs to be recorded;

receiving, at the interactive television system, and in response to the request for the one or more television programs to be recorded, recording instructions that will cause the recording device of the interactive television system to be set up to record the one or more selected television programs, wherein the recording instructions are received from the server through at least one of a television signal and the Internet.

Claim 50 is intended to recite a computer program product comprising computer-readable media having computer-executable instructions for performing the method of claim 44.

In claim 44, there is an “interactive television system” that includes “a computing system” and “a recording device.” The computing system may be a computer, for example, and the recording device may be a VCR. (*E.g.*, Specification at ¶¶ 130, 131, 132). Or, a VCR can be constructed that includes both the computing system and the recording device. (*E.g.*, Specification at ¶ 132). In any event, in the claimed method, there is first a request to a server for a program schedule that identifies one or more television programs that can be received by the interactive television system. The request for the schedule is sent from the computing system portion of the interactive television system. The server then provides the program schedule to the computing system, where the schedule is displayed.

Figure 19 (reproduced below) illustrates an example of the display of a program schedule at the computing system:

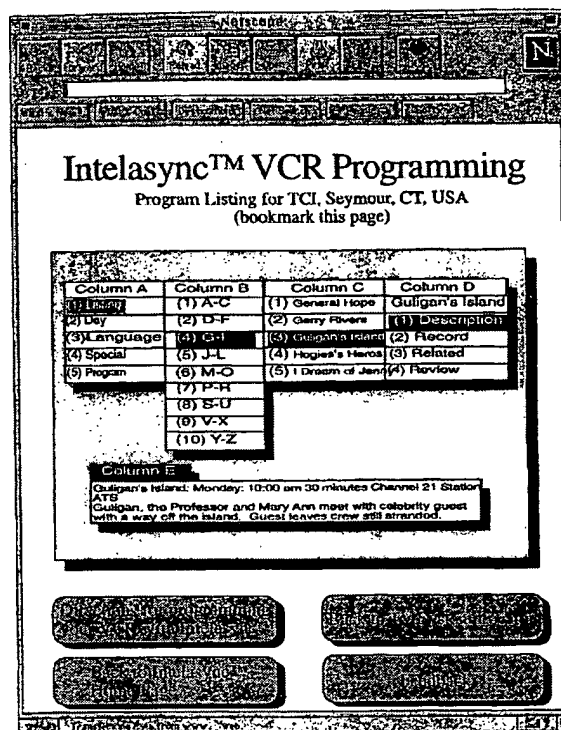


Figure 19

Figure 19 illustrates a web page that is being displayed on a television or computer monitor that can be made accessible to the user through an Internet connection or via another information transfer mechanism. (Specification at ¶ 144). Other types of displays of program schedules are provided in the specification. In the particular display illustrated in Figure 19, the user can search for a television program by first selecting one of the options under column A. (Specification at ¶ 145). In the example shown, the user has selected "listing" under column A. In the example shown, when the user selected "listing" in column A, column B popped up or became activated, presenting the options of the letters of the alphabet to the user. (Specification at ¶ 146). The user in this case has selected letters G-I. With this option selected, column C popped up with a list of television programs that start with the letters G-I. The user in this case has selected from column C the program "Guligan's Island" and therefore column D has popped up with various options. The user in this case has selected the "description" option, and

receives recording instructions from the server either through a television signal or the Internet or both. The recording instructions will cause the recording device to be set up to record the selected television programs. Recording instructions “include[] data such as time, channel, duration, repeat, date, etc. necessary to specify the program that has been selected to be recorded.” (Specification at ¶ 131). Significantly, the computing system does not use the information already provided with the program schedule as recording instructions, but instead seeks (and uses) recording instructions *from the server received in response to* a selection from the schedule. In other words, *two* requests are made of the server, not just one: one request for the programming schedule and *another* request for recording instructions.

Whereas claim 44 recites the method that is performed at one or both portions of the interactive television system, claim 37 recites the method that is performed at the server. Claim 37 reads as follows:

37. In a server that communicates with an interactive television system that includes a computing system and a recording device that is configured to record television programs, and wherein the interactive television system is connectable by means of the computing system to a server that is connectable to a network, a method for enabling the server to control the recording of one or more selected television programs by the interactive television system, the method comprising the acts of:

- receiving at the server a request from a computing system for a programming schedule that identifies one or more television programs, the request being made at the computing system;

- in response to the request, the server providing the programming schedule to the computing system;

- receiving, at the server, an identification provided from the computing system of one or more television programs to be recorded, the one or more television programs to be recorded having been selected from a display of the programming schedule at the computing system; and

- in response to the one or more television programs being identified for recording, the server, downloading recording instructions to the interactive television system so that the recording device will thereafter be set up to record the one or more selected television programs, wherein the recording instructions are downloaded from the server through at least one of a television signal and the Internet.

Thus, in the method recited in claim 37, a request is made at the computing system for a programming schedule, and that request is received by the server. The server then provides the programming schedule to the computing system in response to that request. An example of the display of such a programming schedule has already been seen in Figures 19 and 23. As seen in Figures 19 and 23, the user can then identify one or more television programs from the programming schedule to be recorded. In claim 37, once that identification is made, the identification is sent to and received at the server. *In response*, the server downloads recording instructions to the interactive television system (which includes the computing system and the recording device) through either a television signal or the Internet or both. The specification explains that recording instructions can “include[] data such as time, channel, duration, repeat, date, etc. necessary to specify the program that has been selected to be recorded.” (Specification at ¶ 131). Significantly, the recording instructions are sent by the server *in response to* a selection from the programming schedule, not with the programming schedule. In other words, *two* requests are received by the server, not just one: one request for the programming schedule and *another* request for recording instructions.

Claim 58 is intended to recite a computer program product comprising computer-readable media having computer-executable instructions for performing the method of claim 37.

Figures 7 and 8 and corresponding Figures 9-10 and 15-18 provide examples of the steps set forth in the claims in flow-chart fashion. Figures 7, 8, and 9 are reproduced below:

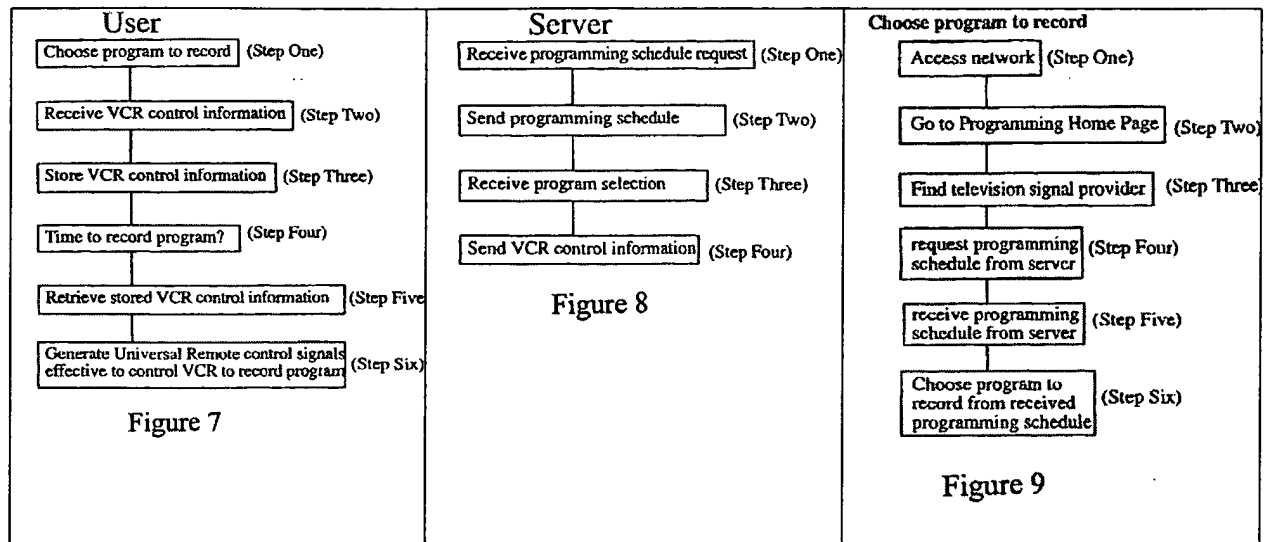


Figure 7 is a flow chart illustrating the basic steps performed at the user-end. (Specification at ¶ 43). Figure 8 is a flow chart showing the basic steps performed at the server-end. (Specification at ¶ 44). Figure 9 is a flow chart more specifically illustrating “Step One” in Figure 7. (Specification at ¶¶ 45, 134, 135). Notice in Figure 7 that “VCR control information” is received *after* the step “Choose Program To Record.” Notice in Figure 8 that “VCR control information” is sent *after* the step “Send Program Schedule” and *after* the step “Receive Program Selection.”

The steps shown in these figures correspond to the steps set forth in the claims: Step Four of Figure 9 (and Step One of Figure 8) corresponds to the first step of claim 44,² Step Five of Figure 9 (and Step Two of Figure 8) corresponds to the second step of claim 44,³ Step Six of Figure 9 corresponds to the third and fourth steps of claim 44,⁴ Step Three of Figure 8

² “sending, from the computing system, a request to the server for a program schedule that identifies television programs that can be received by the interactive television system”

³ “receiving, at the computing system, the program schedule from the server”

⁴ “displaying, at the computing system, the program schedule after it is received from the server;
“receiving, at the computing system, a user selection of one or more television programs from the program schedule”

corresponds to the fifth step of claim 44,⁵ and Step Two of Figure 7 (and Step Four of Figure 8) corresponds to the sixth step of claim 44.⁶

Similarly, Step One of Figure 8 (and Step Four of Figure 9) corresponds to the first step of claim 37,⁷ Step Two of Figure 8 (and Step Five of Figure 9) corresponds to the second step of claim 37,⁸ Step Three of Figure 8 (and Step Six of Figure 9) corresponds to the third step of claim 37,⁹ and Step Four of Figure 8 (and Step Two of Figure 7) corresponds to the fourth step of claim 37.¹⁰ Once again, it should be emphasized that the recording instructions (e.g., VCR control information) are sent by the server *after* and *in response to* a selection from the programming schedule, not with the programming schedule. (*See also* Specification at ¶ 133 (“*Upon receiving the data of the choice of the program to record, the server retrieves the program selection . . . and then sends the VCR control information . . .*”)).

⁵ “sending, from the computing system, a request to the remote server for the selected one or more television programs to be recorded”

⁶ “receiving, at the interactive television system, and in response to the request for the one or more television programs to be recorded, recording instructions that will cause the recording device of the interactive television system to be set up to record the one or more selected television programs, wherein the recording instructions are received from the server through at least one of a television signal and the Internet.”

⁷ “receiving at the server a request from a computing system for a programming schedule that identifies one or more television programs, the request being made at the computing system”

⁸ “in response to the request, the server providing the programming schedule to the computing system”

⁹ “receiving, at the server, an identification provided from the computing system of one or more television programs to be recorded, the one or more television programs to be recorded having been selected from a display of the programming schedule at the computing system”

¹⁰ “in response to the one or more television programs being identified for recording, the server, downloading recording instructions to the interactive television system so that the recording device will thereafter be set up to record the one or more selected television programs, wherein the recording instructions are downloaded from the server through at least one of a television signal and the Internet.”

ISSUES TO BE REVIEWED ON APPEAL

1. Did the Examiner err in rejecting claims 3-8, 13-15, 27-30, 37-76, and 78 under 35 U.S.C. § 103(a) as being unpatentable over Schein et al. (U.S. Pat. No. 6,388,714) in view of Klosterman (U.S. Patent No. 5,550,576)?^{11,12}

ARGUMENT

I. Introduction

The Examiner has failed to establish a prima facie case of obviousness for any of claims 3-8, 13-15, 27-30, 37-76, and 78 because the combination of references relied on by the Examiner does not disclose the requesting / sending of recording instructions from a server “*in response to*” the selection of a television program, as the claims require. Even if the Examiner has established the disclosure of these claim requirements, the Examiner has still failed to establish a prima facie case of obviousness for five other groups of claims: (1) Claims 38, 45, 52, and 59; (2) Claim 67; (3) Claims 69-72; (4) Claim 73; and (5) Claim 75. The Examiner’s rejection should be overturned.

II. The Examiner Has Not Established A Prima Facie Case of Obviousness For Any Claim

A. The Examiner Has Not Established A Prima Facie Case of Obviousness For Claims 3-8, 13-15, 27-30, 37-76, and 78 Because The Combination Relied On By The Examiner Does Not Disclose The Requesting/Sending of Recording Instructions From A Server In Response To The Selection of a Television Program

The Examiner has rejected all pending claims under 35 U.S.C. § 103(a) as being unpatentable over Schein et al. (U.S. Pat. No. 6,388,714) in view of Klosterman (U.S. Pat. No.

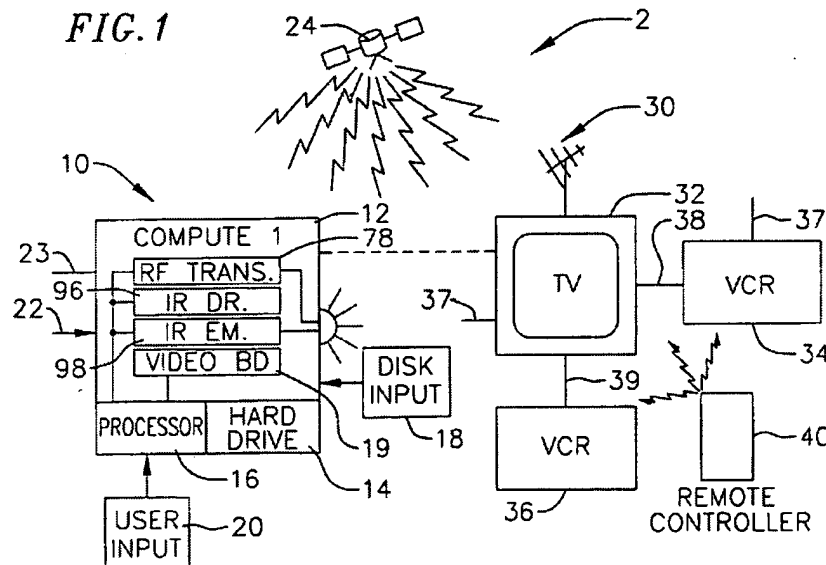
¹¹ Applicant does not contest the Examiner’s rejection of claim 77 on written description grounds. (Office Action mailed October 19, 2005, p. 2). Counsel for the Appellant made a telephonic request for an Examiner’s Amendment to cancel claim 77 on December 19, 2005, and submitted an Supplemental Amendment “H” pursuant to 37 C.F.R. § 41.33 on February 17, 2006 to cancel claim 77, but neither of these amendments has yet been entered.

¹²If Supplemental Amendment “H” is entered, then claims 42 and 48 need not be considered, because they have been cancelled in that Amendment.

5,550,576). In the Final Office Action mailed October 19, 2005, the Examiner relies on the reasoning set forth in a previous Office Action mailed July 18, 2005. (See Office Action mailed October 19, 2005, p. 3).

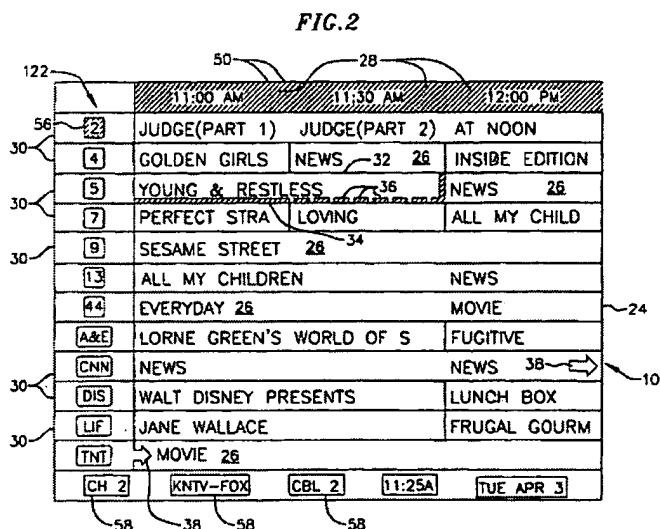
The Examiner's rejection is erroneous because neither Schein nor Klosterman discloses a first request to a server for a programming schedule and then a second request for recording instructions made *in response to* the selection from that schedule, as the claims require. At most, both Schein and Klosterman disclose only a single request to a server for a programming schedule, and neither discloses a request to the server *in response to* a selection from that schedule.

One embodiment disclosed in Schein is illustrated in Figure 1 of that patent:



Schein explains that line 22 is a telephone line which provides access to the internet or to an on-line service. (5:36-37). Schein explains that line 22 can also be a coax cable, optical fiber or other land line. (5:43-44). In other embodiments, RF transmitter 78, IR driver 96, and IR emulator 98 can be located in a computer accessory 70 or VCR connector 90, as shown in Figures 3 and 4. (6:48-7:30; 8:17-19; 8:37-39; 8:44-46). Data needed to generate a television

schedule is downloaded via line 22 to hard drive 14 of computer 12. (9:44-46; 9:63-64; 5:45-48; 9:7-9). Figure 2 illustrates an example of such a television schedule:

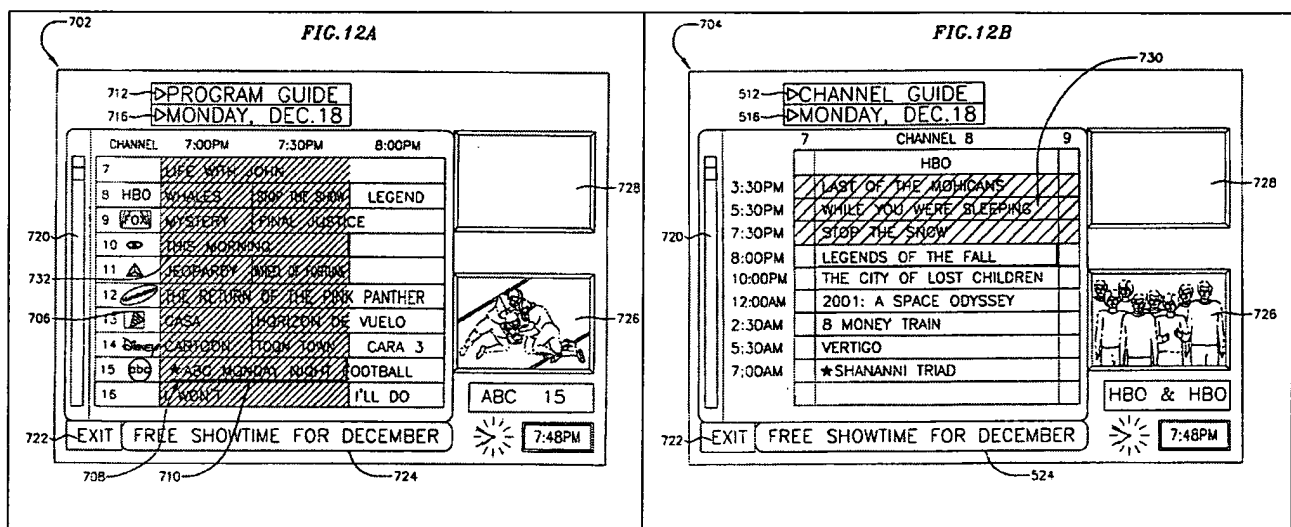


Schein further states that the user “can select different programs for automatic recording and/or retrieval and digital storage.” (6:8-9). When this occurs, the system apparently uses information that it already has in order to carry out the recording, because the following is the disclosure of Schein as to how the recording occurs: “software determines if the time for the automatic tune or record is equal to the present time. If the program start time is not equal to the present time, then the software waits.... If the time equals the present time, then the software performs automatic tuning or automatic recording....” (10:8-12; *see also* 6:29-47; 7:49-53; 8:24-27). In an embodiment using computer accessory 70 disclosed in Figure 3, Schein states that “memory 76 contains the key parameters need for recording and/or tuning to a selected television program. These parameters include the date of the program, the start time for the program, the end time for the program, the television channel providing the program, and which peripheral device shall be addressed for recording or viewing the program.” (6:65-7:3).

Significantly, Schein does not state that (1) “a request” is sent to a “remote server” for such parameters “for the selected one or more television programs” or (2) that such parameters

are received “*in response to*” such a request, as steps five and six of claims 44 and 50 require. Moreover, Schein does not state that (1) “an identification...of the one or more television programs to be recorded” is “receiv[ed], *at the server*” or (2) that the server downloads such parameters “*in response to*” the one or more television programs being identified, as steps three and four of claims 37 and 58 require.

Schein discloses another “program guide” and a “channel guide” in Figures 12A and 12B. These figures are reproduced below:



The Examiner asserts that item 724 in Figure 12A is “an identification....of one or more television programs to be recorded” that is sent to a server, as required by claim 37. (Office Action mailed July 18, 2005, pp. 2-3). The Examiner also asserts that item 724 is “input received at the remote device.” (*Id.* at p. 3). This is plainly incorrect. Schein expressly states that item 724 is “*a scrolling commercial message . . . that advertises programs or products from program sponsors, etc.*” (18:22-25). The Examiner’s assertion is clearly erroneous.

To be sure, Schein explains that a user can use cursor 710 to select a television program in one of these guides. (17:51). In Figure 12B, the cursor is highlighting the television program entitled “LEGENDS OF THE FALL.” But Schein does not say that once the television program

is selected, an identification of the program or a request is sent to a server, as required by claims 37 and 44. Nor does Schein say that in response to such a request, the server sends recording instructions, as required by claims 37 and 44.

The Examiner also relies on Figure 14. (Office Action mailed July 18, 2005, at p. 3). In Figure 14A (reproduced below), the user has opened up an “InfoMenu” that is apparently associated with a television program. (19:8). As can be seen, the user could choose the option in the “InfoMenu” labeled “(3) Record This Program”:

FIG. 14A

-HOURS	
MOVIES: DRAMA	
(1)	MORE INFORMATION
(2)	TUNE TO THIS CHANNEL NOW
(3)	RECORD THIS PROGRAM
(4)	PUT THIS PROGRAM ON MY FAVORITES LIST
(5)	REMIND ME WHEN THIS PROGRAM AIRS
(6)	RESTRICT ACCESS TO THIS PROGRAM
(7)	LINKED SERVICE
(0) GO BACK TO PROGRAM GUIDE	

However, once again, there is no disclosure in Schein as to the method that would be used to record the program if that option were selected by a user. There is certainly no disclosure that (1) “a request” for the selected program would be sent to a “remote server” or (2) that recording instructions would be sent “*in response to*” such a request, as steps five and six of claims 44 and 50 require. Nor is there any disclosure that (1) “an identification...of the one or more television programs to be recorded” would be “receiv[ed], at the server” or (2) that the server would download recording instructions “in response to” the one or more television programs being identified, as steps three and four of claims 37 and 58 require.

Instead, Schein explains only that if the user chooses the option labeled “(7) Linked Service,” then he can order this program as “video on demand.” (19:6-7). Figure 14B

(reproduced below) shows the menu that appears when the “Linked Service” option is selected, and Figure 14C (reproduced below) shows a screen in which the user is prompted to enter a password in order to get on-demand delivery of the “Legends of the Fall” program. (19:9-20):

FIG. 14B

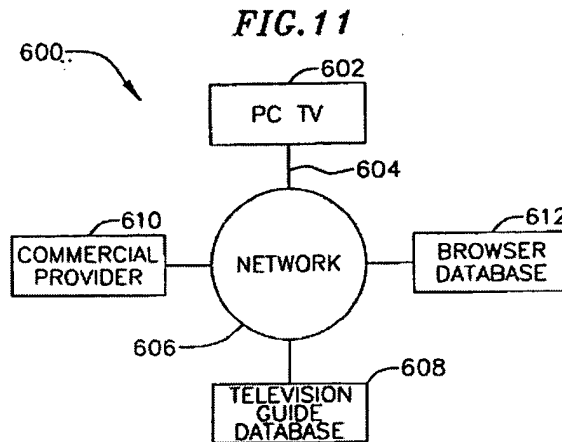
MOVIES: DRAMA	
(1) MORE INFORMATION	
(2) \$ ORDER MOVIE WHEN YOU LIKE...	
(3) \$ HBO INTERVIEW: BRAD PIT	
(4) A HOPKINS "REMAINS OF THE DAY"	
(5) \$ UNIVERSAL PICTURES ONLINE...	
(6) \$ UNIVERSAL STUDIOS FAMILY TICKET OFFER	
(<) BACK TO PREVIOUS MENU	
(0) GO BACK TO PROGRAM GUIDE	

FIG. 14C

ENTERING PASSWORD							
BY ENTERING YOUR PASSWORD YOU ARE CONFIRMING A PURCHASE OR VALIDATION OF YOUR ID. PLEASE ENTER YOUR PASSWORD TO ORDER THIS MOVIE FOR THE LISTED PURCHASE PRICE.							
HELP: PASSWORD							
(1) INFO ON (LEGENDS OF THE FALL)	\$3.95						
<table border="1"> <tr> <td colspan="2">ENTER PASSWORD FOR DELIVERY IN 7 MINUTES</td> </tr> <tr> <td>● 7:55PM</td> <td>LEGENDS OF THE FALL-\$3.95</td> </tr> <tr> <td colspan="2"> </td> </tr> </table>		ENTER PASSWORD FOR DELIVERY IN 7 MINUTES		● 7:55PM	LEGENDS OF THE FALL-\$3.95	
ENTER PASSWORD FOR DELIVERY IN 7 MINUTES							
● 7:55PM	LEGENDS OF THE FALL-\$3.95						
.							
(2) ACCEPT PASSWORD...							
(<) BACK TO PREVIOUS MENU							
(0) GO BACK TO PROGRAM GUIDE							

There is absolutely no discussion of recording the television program in connection with Figures 14B or 14C, let alone recording the television program as the result of (1) “a request” that is sent to a “remote server” or (2) recording instructions that are sent “*in response to*” such a request, as steps five and six of claims 44 and 50 require. Nor is there any disclosure that (1) “an identification...of the one or more television programs to be recorded” is “receiv[ed], at the server” or (2) that the server downloads recording instructions “in response to” the one or more television programs being identified, as steps three and four of claims 37 and 58 require. The Examiner’s reliance on Figure 14 is clearly misplaced.

The Examiner has also relied on Figure 11 (Office Action mailed July 18, 2005, pp. 2-3), reproduced below:



Schein explains that Figure 11 illustrates “a system and method...for linking television viewers with broadcasters and advertisers during the broadcast of a commercial program.” (16:9-12). Schein explains that there is a “television guide database 608...coupled to the Internet 606 for providing the television schedule information to PCTV 602.” (16:18-20). However, there is absolutely no discussion in connection with Figure 11 of recording a television program, let alone recording the television program as the result of (1) “a request” that is sent to a “remote server” or (2) recording instructions that are sent “*in response to*” such a request, as steps five and six of claims 44 and 50 require. Nor is there any disclosure that (1) “an identification...of the one or more television programs to be recorded” is “receiv[ed], at the server” or (2) that the server downloads recording instructions “in response to” the one or more television programs being identified, as steps three and four of claims 37 and 58 require.

The Examiner concedes that Schein does not disclose all of the requirements of the claims, although it is not clear that the Examiner appreciates precisely which claim requirements are not met by Schein. The Examiner states: “Although Schein et al discloses recording programs in response to the user selection of programs identified for recording, it is noted Schein et al differs from the present invention in that it fails to particularly disclose a method of obtaining recording instructions to control the recording of one or more selected television

programs by the interactive television system as specified in claims 3-8, 13-15, 27-30, and 37-69.” (Office Action mailed July 18, 2005, p. 4 (emphasis added)).

To be more precise, Schein does not disclose that (1) “a request” is sent to a “*remote server*” for “the *selected* one or more television programs to be recorded” or (2) that recording instructions are sent “*in response to*” such a request, as steps five and six of claims 44 and 50 require. Moreover, Schein does not disclose that (1) “an identification...of the one or more television programs to be recorded” is “receiv[ed], *at the server*” or (2) that the server downloads recording instructions “*in response to*” the one or more television programs being identified, as steps three and four of claims 37 and 58 require.

In an effort to supply the claim requirements that are not disclosed in Schein, the Examiner relies on Klosterman (U.S. Pat. No. 5,550,576). However, Klosterman does not disclose the claim requirements that are lacking in Schein.

Figures 1A through 1D of Klosterman disclose a variety of configurations of a system that manages television programs received from multiple sources. Figure 1A, for example, is reproduced below:

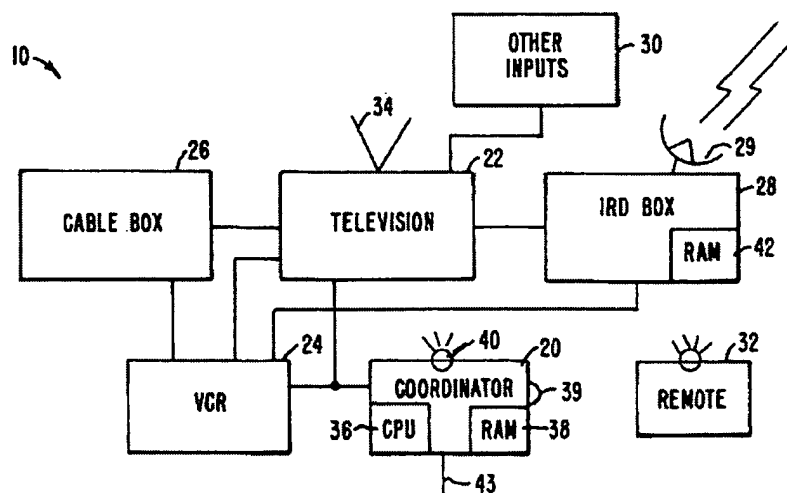


FIG. 1A.

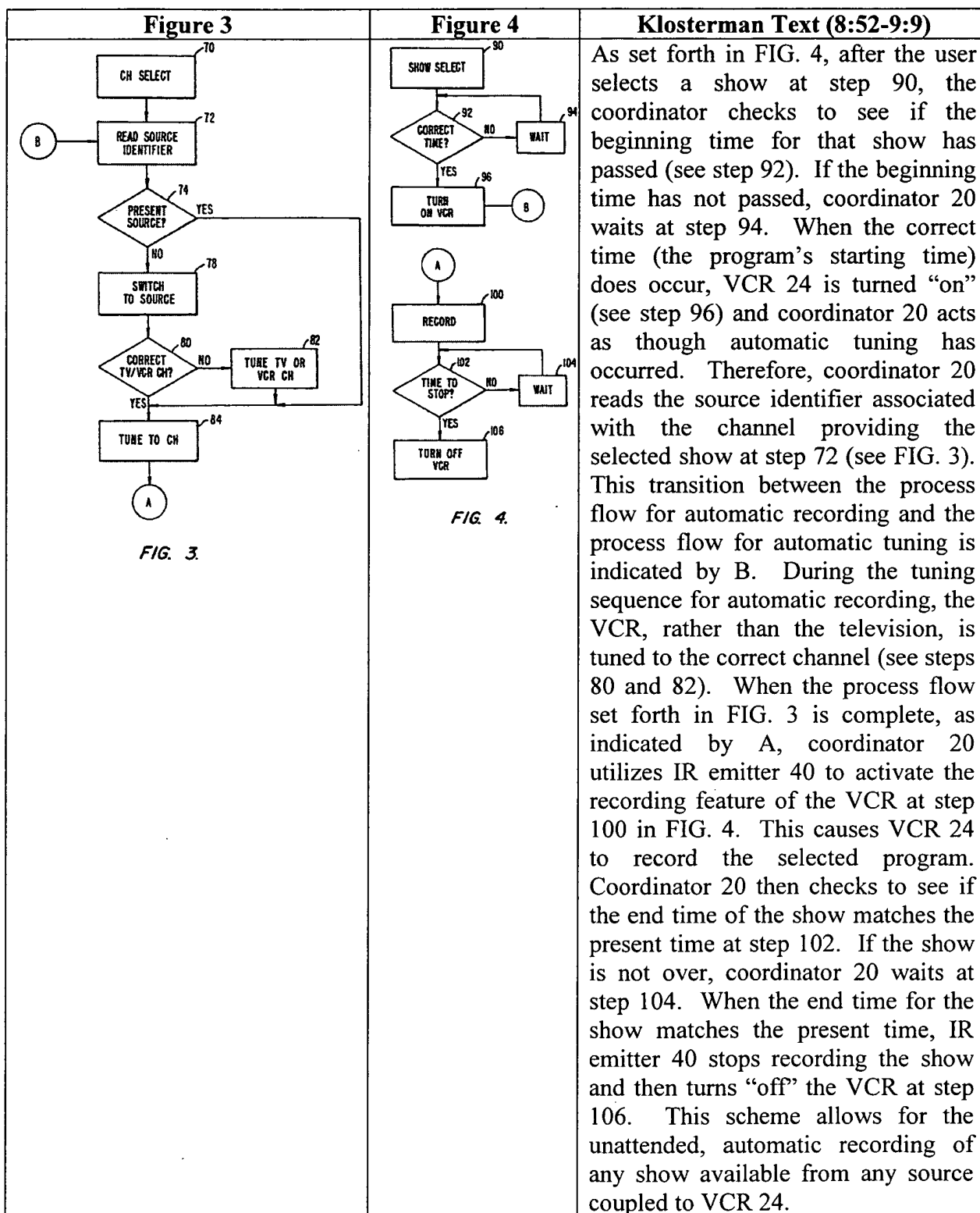
As can be seen, television 22 and VCR 24 are provided with input from cable box 26 and a satellite IRD box 28. (3:65-66). Other inputs 30 may also be supplied to the television 22 and/or VCR 24. (3:66-67). The system operates under the control of coordinator 20. (3:64-65; 4:17-30).

IRD box 28 receives television programs along with program schedule information transmitted by the satellite service provider. (4:46-55). Program schedule information can also be provided through cable box 26 or other inputs 30. (4:56-58). Figure 2 is an example of an on-screen display of a schedule grid guide that has been assembled from the program schedule information:

CH	1:00 P.M.	1:30 P.M.	2:00 P.M.	...
2	BATMAN TM		SOAP TM	
3	E.T. TM			
4	NEWS		SPORT EVENT	
HBO	SPECIAL	PRESENTATION		
...				

FIG. 2.

Klosterman explains that a remote 32 (shown in Figure 1A) can be used to select a certain channel or show for automatically recording a television show. (7:19-25). As with Schein, however, the Klosterman system apparently uses information that it already has in order to carry out the recording. The process used for recording a selected television show is set forth in Figures 3 and 4 and described as follows:



As is apparent from this disclosure, Klosterman does not state that (1) “a request” is sent to a “remote server” for “the selected one or more television programs to be recorded” or (2) that recording instructions are sent “*in response to*” such a request, as steps five and six of claims 44 and 50 require. Likewise, Klosterman does not state that (1) “an identification...of the one or more television programs to be recorded” is “receiv[ed], *at the server*” or (2) that the server downloads recording instructions “in response to” the one or more television programs being identified, as steps three and four of claims 37 and 58 require. Instead, the Klosterman system apparently uses information that it already has in order to carry out the recording.

The Examiner’s description of Klosterman shows that the Examiner was apparently not aware of these limitations of the claims. The Examiner describes Klosterman as follows:

Klosterman, however, in Figures 1-4, teaches the concept of such well known technique of identifying a plurality of television signal providers (26-30); receiving a selection of an appropriate one of the plurality of television signal providers (26-30); downloading recording instructions (e.g. source ID, CH, time, etc.) to the interactive television system so that the recording device 24 will thereafter be set up to record the one or more selected television programs (Fig. 2), and wherein the recording instructions (e.g. VCR stop time) are downloaded through at least one of a television signal (26-30).

(Office Action mailed July 18, 2005, p. 4). In the Final Rejection, the Examiner reiterated: “Figure 1 of Klosterman illustrate[s] the concept of such recording instructions (e.g. source, time, etc.) being downloaded from various sources 26-30.” (Office Action mailed October 19, 2005, p. 3).

The problem is that the “recording instructions” (source ID, CH, time etc.) to which the Examiner points are not downloaded in the appropriate order and in response to the acts required by the claims. Significantly, the Examiner does not say that Klosterman teaches that (1) “an identification...of the one or more television programs to be recorded” is “receiv[ed], *at the server*” or (2) that the server downloads recording instructions (e.g. source ID, CH, time, etc.)

“in response to” the one or more television programs identified, as steps three and four of claims 37 and 58 require. Likewise, the Examiner does not say that Klosterman teaches that (1) “a request” “for the *selected* one or more television programs” is sent to a “remote server” for recording instructions (e.g. source ID, CH, time, etc.) or (2) that recording instructions (e.g. source ID, CH, time, etc.) are sent “in response to” such a request, as steps five and six of claims 44 and 50 require. Thus, even the Examiner’s characterization of Klosterman is insufficient to establish the presence of the claim limitations lacking in Schein.

As such, the Examiner has failed to establish a prima facie case of obviousness. Neither Schein nor Klosterman discloses a first request to a server for a programming schedule and then a second request for recording instructions *from a server sent in response to* a selection from that schedule. At most, both Schein and Klosterman disclose only a single request to a server for a programming schedule, and neither discloses a request to the server in response to a selection from that schedule. Nor has the Examiner pointed to any motivation or suggestion that would have motivated a person of ordinary skill in the art to modify Schein or Klosterman so as to meet the requirements of the claims. Indeed, the order and timing required by the claims is counterintuitive when viewed in light of Schein and Klosterman. Therefore, the Examiner’s rejection as to all claims must be reversed.

B. The Examiner Has Not Established A Prima Facie Case of Obviousness For Claims 38, 45, 52, and 59 Because The Examiner Has Not Pointed To Any Disclosure of Recording Instructions Including A Record Command

Even if the Examiner has established a prima facie case of obviousness for the other claims, he has not done so for claims 38, 48, 52, and 59. These claims require that “the recording instructions include a record command for the recording device.” The only recording instructions identified by the Examiner include “source ID, CH [channel], time, etc.” (Office Action mailed July 18, 2005, at p. 4; Office Action mailed October 19, 2005, at p. 3). Thus, the

Examiner has failed to establish a prima facie case of obviousness with respect to claims 38, 45, 52, and 59.¹³

C. The Examiner Has Not Established A Prima Facie Case of Obviousness For Claim 67 Because The Combination Relied On By The Examiner Does Not Disclose Access To A Programming Homepage Only After Screening A User Via A Password

Even if the Examiner has established a prima facie case of obviousness for the other claims, he has not done so for claim 67. Claim 67 requires that “access to the programming homepage is accessible only after screening a user via a password.” The Examiner asserts that this limitation is disclosed in Figure 17 of Schein. (Office Action mailed July 18, 2005, p. 4). However, Schein makes clear that in Figures 17A-17D, the user access the program guide *before* entering a password, not after. The password entered in Figure 17D is only entered *after* the user has viewed the program guide, selected a particular program from the guide, chosen “Linked Service” from the resulting “InfoMenu,” and then “Purchase Washington Redskins Cap.” (20:19-39). Thus, the Examiner has failed to establish a prima facie case of obviousness as to claim 67.

D. The Examiner Has Not Established A Prima Facie Case of Obviousness For Claim 69-72 Because The Combination Relied On By The Examiner Does Not Disclose That Programming Information Is Made Available Based On A Caller ID, Area Code, Or Phone Number

Even if the Examiner has established a prima facie case of obviousness for the other claims, he has not done so for claims 69-72. Claim 69 requires making programming information available to the user based on the user’s caller ID, area code, or phone number, or any combination thereof. Claim 70 requires making appropriate programming information

¹³ As pointed out in “Amendment G,” Schein and Klosterman appear to disclose a recording instruction that does comprise a record command, but that command is *generated* at the interactive television system, and not downloaded from a server. The Examiner does not point to or rely on that recording instruction (and rightfully so, because it is not downloaded from a server), but points to program schedule information downloaded from a server. Yet, the Examiner has not pointed to any disclosure of a “record command” being downloaded with the program schedule information. Either way, the claims’ requirements are not disclosed in Schein or Klosterman.

available based on the locality of a user's modem. Claim 71 requires making appropriate programming information available based on a caller ID associated with the user's modem. Claim 72 requires making programming information available to the user based on a phone number of the user. The Examiner asserts that this limitation is disclosed in Schein and/or Klosterman merely because "modem dial up access" is disclosed. (Office Action mailed July 18, 2005, p. 4). But the fact that "modem dial up access" is used does not mean that the server is making itself aware of the locality of that modem (either through caller ID, or the area code or phone number of the modem) in order to send appropriate programming information based on that locality. Thus, the Examiner has failed to establish a prima facie case of obviousness as to claims 69-72.

E. The Examiner Has Not Established A Prima Facie Case of Obviousness For Claim 73 Because The Examiner Has Not Pointed To Any Disclosure Of The Transmission Of An End-Of VCR Control Information

Even if the Examiner has established a prima facie case of obviousness for the other claims, he has not done so for claim 73. Claim 73 requires "subsequent to downloading recording instructions, the server transmits data comprising an end-of VCR control information to the computing system." This is disclosed in Figure 10 and paragraph 135 of the specification. The Examiner has not even attempted to point to any disclosure in Klosterman or Schein disclosing the transmission of recording instructions with this type of data. (Office Action mailed July 18, 2005 at *passim*; Office Action mailed October 19, 2005 at *passim*). Therefore, the Examiner has failed to establish a prima facie case of obviousness as to claim 73.

F. The Examiner Has Not Established A Prima Facie Case of Obviousness For Claim 75 Because The Examiner Has Not Pointed To Any Disclosure Of a Binary ASCII-format Character String That Is Assigned Specific Control Functions

Even if the Examiner has established a prima facie case of obviousness for the other claims, he has not done so for claim 75. Claim 75 requires that recording instructions embedded in and received with television programs are inserted as “a binary ASCII-format character string that is assigned specific control functions.” This is disclosed in paragraph 144 of the specification. The Examiner has not even attempted to point to any disclosure in Klosterman or Schein disclosing the transmission of recording instructions with this type of data. (Office Action mailed July 18, 2005 at *passim*; Office Action mailed October 19, 2005 at *passim*). Thus, the Examiner has failed to establish a prima facie case of obviousness as to claim 75.

CONCLUSION

For the foregoing reasons, Appellant respectfully requests the Board to overturn the Examiner’s rejections of the appealed claims 3-8, 13-15, 27-30, 37-76, and 78.

Dated this 21st day of February 2006.

Respectfully submitted,



RICK D. NYDEGGER
Registration No. 28,651
DAVID R. TODD
Registration No. 41,348
JENS C. JENKINS
Registration No. 44,803
Attorneys for Applicant
Customer No. 047973

CLAIMS APPENDIX¹⁴

1-2. (Canceled)

3. (Previously Presented) A method as recited in claim 37, further comprising the act of receiving, from the remote device, information representing a television signal provider that is to broadcast the one or more television programs to be recorded by the interactive television system, wherein the television signal provider has been selected at the remote device in response to input received at the remote device.

4. (Previously Presented) A method as recited in claim 3, further comprising, prior to the act of receiving information representing a television signal provider, the act of transmitting, to the remote device, information identifying a plurality of television signal providers that are capable of broadcasting television programs to the interactive television system.

5. (Previously Presented) A method as recited in claim 37, wherein the server communicates with the remote device through an Internet connection.

6. (Previously Presented) A method as recited in claim 37, wherein the programming schedule includes a time, date and duration of the one or more television programs that are to be recorded.

7. (Previously Presented) A method as recited in claim 37, wherein the programming schedule include transmission source information that enables the interactive television system to tune to one or more signals in which the one or more television programs are encoded.

¹⁴ The claims are presented in their current status. The claims do not reflect "Supplemental Amendment H" submitted pursuant to 37 C.F.R. § 41.33(a) on February 17, 2006, because that Amendment has not yet been entered.

8. (Previously Presented) A method as recited in claim 7, wherein the transmission source information identifies at least one of a television broadcast channel, a cable channel, and a satellite channel through which the one or more signals is to be received by the interactive television system.

9-12 (Canceled)

13. (Previously Presented) A method as recited in claim 44, wherein the act of receiving the program schedule comprises an act of accessing a web page from the server.

14. (Previously Presented) A method as recited in claim 13, wherein the web page identifies at least one television signal provider corresponding to a location of the interactive television system.

15. (Previously Presented) A method as recited in claim 44, further comprising the acts of:

prior to sending the first request, receiving user input at the computing device selecting a television signal provider associated with a location of the interactive television system; and
transmitting information representing the selection of the television signal provider to the server.

16-26. (Canceled)

27. (Previously Presented) A computer program product as recited in claim 50, wherein the programming schedule identifies a time, date and duration of the one or more television programs to be recorded.

28. (Previously Presented) A computer program product as recited in claim 50, wherein the programming schedule includes transmission source information that enables the interactive television system to tune to one or more signals in which the one or more selected television programs are encoded.

29. (Previously Presented) A computer program product as recited in claim 28, wherein the transmission source information identifies at least one of a television broadcast channel, a cable channel, and a satellite channel through which the one or more signals is to be received by the interactive television system.

30. (Previously Presented) A computer program product as recited in claim 50, wherein the computing device and the server are connected through an Internet connection.

31-36. (Canceled)

37. (Previously Presented) In a server that communicates with an interactive television system that includes a computing system and a recording device that is configured to record television programs, and wherein the interactive television system is connectable by means of the computing system to a server that is connectable to a network, a method for enabling the server to control the recording of one or more selected television programs by the interactive television system, the method comprising the acts of:

receiving at the server a request from a computing system for a programming schedule that identifies one or more television programs, the request being made at the computing system;

in response to the request, the server providing the programming schedule to the computing system;

receiving, at the server, an identification provided from the computing system of one or more television programs to be recorded, the one or more television programs to be recorded having been selected from a display of the programming schedule at the computing system; and

in response to the one or more television programs being identified for recording, the server, downloading recording instructions to the interactive television system so that the recording device will thereafter be set up to record the one or more selected television programs, wherein the recording instructions are downloaded from the server through at least one of a television signal and the Internet.

38. (Previously Presented) A method as recited in claim 37, wherein the recording instructions include a record command for the recording device.

39. (Previously Presented) A method as recited in claim 38, wherein the recording device is a VCR.

40. (Previously Presented) A method as recited in claim 37, wherein the recording instructions include the time, date and duration of the one or more television programs to be recorded.

41. (Previously Presented) A method as recited in claim 37, wherein the recording

instructions include transmission information that enables the interactive television system to tune to one or more signals in which the one or more television programs to be recorded are encoded.

42. (Previously Presented) A method as recited in claim 37, wherein the remote device comprises the computing system of the interactive television system.

43. (Previously Presented) A method as recited in claim 37, wherein the computing system and the recording device are integrated into a single device.

44. (Previously Presented) In an interactive television system that includes a computing system and a recording device that is configured to record television programs, and wherein the interactive television system is connectable by means of the computing system to a server that is connectable to a network, a method for enabling the server to control the recording of one or more selected television programs by the interactive television system, the method comprising the acts of:

- sending, from the computing system, a request to the server for a program schedule that identifies television programs that can be received by the interactive television system ;

- receiving, at the computing system, the program schedule from the server;

- displaying, at the computing system, the program schedule after it is received from the server;

- receiving, at the computing system, a user selection of one or more television programs from the program schedule;

- sending, from the computing system, a request to the remote server for the selected one or more television programs to be recorded;

- receiving, at the interactive television system, and in response to the request for the one or more television programs to be recorded, recording instructions that will cause the recording device of the interactive television system to be set up to record the one or more selected television programs, wherein the recording instructions are received from the server through at least one of a television signal and the Internet.

45. (Previously Presented) A method as recited in claim 44, wherein the recording instructions include a record command for the recording device.

46. (Previously Presented) A method as recited in claim 45, wherein the recording device is a VCR.

47. (Previously Presented) A method as recited in claim 44, wherein the recording instructions include at least one of the time, date, duration and tuning instructions corresponding to the one or more television programs to be recorded.

48. (Previously Presented) A method as recited in claim 44, wherein the computing device comprises part of the interactive television system.

49. (Previously Presented) A method as recited in claim 44, wherein the computing device and the recording device are integrated into a single device.

50. (Previously Presented) In an interactive television system that includes a computing system and a recording device that is configured to record television programs, and wherein the interactive television system is connectable by means of the computing system to a server that is connectable to a network, a method for enabling the server to control the recording of one or more selected television programs by the interactive television system, a computer program product comprising:

one or more computer-readable media having computer-executable instructions for implementing a method for enabling the server to control the recording of one or more television programs that are selected by the computing device and that are recorded by the recording device of the interactive television system, the method including the acts of:

sending, from the computing system , a request to the server for a program schedule that identifies television programs that can be received by the interactive television system;

receiving, at the computing system, the program schedule from the server;

displaying, at the computing system, the program schedule after it is received from the server;

receiving, at the computing system, a user selection of one or more television programs from the program schedule;

sending, from the computing system, a request to the remote server for the selected one or more television programs to be recorded;

receiving, at the interactive television system, and in response to the request for the one or more television programs to be recorded, recording instructions that will cause the recording device of the interactive television system to be set up to record the one or more selected television programs, wherein the recording instructions are received from the server through at least one of a television signal and the Internet.

51. (Previously Presented) A computer program product as recited in claim 50, wherein the act of receiving the program schedule comprises an act of accessing a web page from the server.

52. (Previously Presented) A computer program product as recited in claim 50, wherein the recording instructions include a record command for the recording device.

53. (Previously Presented) A computer program product as recited in claim 52, wherein the recording device is a VCR.

54. (Previously Presented) A computer program product as recited in claim 50, wherein the recording instructions include the time, date and duration of the one or more television programs to be recorded.

55. (Previously Presented) A computer program product as recited in claim 50, wherein the recording instructions include transmission information that enables the interactive television system to tune to one or more signals in which the one or more television programs to be recorded are encoded.

56. (Previously Presented) A computer program product as recited in claim 50, wherein the remote device comprises the computing system of the interactive television system.

57. (Previously Presented) A computer program product as recited in claim 50, wherein the computing system and the recording device are integrated in a single device.

58. (Previously Presented) In a server that communicates with an interactive television system that includes a computing system and a recording device that is configured to record television programs, and wherein the interactive television system is connectable by means of the computing system to a server that is connectable to a network, a method for enabling the server to control the recording of one or more selected television programs by the interactive television system, a computer program product comprising:

receiving at the server a request from a computing system for a programming schedule that identifies one or more television programs, the request being made at the computing system;

in response to the request, the server providing the programming schedule to the computing system;

receiving at the server an identification provided from the computing system of one or more television programs to be recorded, the one or more television programs to be recorded having been selected from a display of the programming schedule at the computing system ; and

in response to the one or more television programs being identified for recording, the server, downloading recording instructions to the interactive television system so that the recording device will thereafter be set up to record the one or more selected television programs, wherein the recording instructions are downloaded from the server through at least one of a television signal and the Internet.

59. (Previously Presented) A computer program product as recited in claim 58, wherein the recording instructions include a record command for the recording device.

60. (Previously Presented) A computer program product as recited in claim 59 wherein the recording device is a VCR.

61. (Previously Presented) A computer program product as recited in claim 58, wherein the recording instructions include at least one of the time, date, duration and tuning instructions corresponding to the one or more television programs to be recorded.

62. (Previously Presented) A computer program product as recited in claim 58, wherein the computing device comprises part of the interactive television system.

63. (Previously Presented) A computer program product as recited in claim 58, wherein the computing device and the recording device are integrated into a single device.

64. (Previously Presented) A method as recited in claim 37, wherein the request for a programming schedule is received at an Internet web site through the use of a conventional Web browser.

65. (Previously Presented) A method as recited in claim 37, wherein the programming schedule is provided through a web page of the server.

66. (Previously Presented) A method as recited in claim 65, wherein prior to providing the programming schedule, user input is received at the web page identifying a television programming provider.

67. (Previously Presented) A method as recited in claim 76, wherein access to the programming homepage is accessible only after screening a user via a password.

68. (Previously Presented) A method as recited in claim 37, wherein the recording instructions are embedded in and received with the television programs.

69. (Previously Presented) A method as recited in claim 37, wherein the programming information is made available to the user based on a determination of at least one of a caller ID, area code and phone number of the user.

70. (Previously Presented) A method as recited in claim 37, wherein appropriate programming information to be sent to the computing system within the programming schedule is based on determining a locality of a user's modem.

71. (Previously Presented) A method as recited in claim 70, wherein the locality of the user's modem is determined according to a caller ID.

72. (Previously Presented) A method as recited in claim 69, wherein the locality of the user's modem is determined according to a phone number.

73. (Previously Presented) A method as recited in claim 37, wherein subsequent to downloading recording instructions, the server transmits data comprising an end-of VCR control information to the computing system.

74. (Previously Presented) A method as recited in claim 68, wherein the recording instructions are embedded in and received with the television programs by being inserted in special television channel.

75. (Previously Presented) A method as recited in claim 68, wherein the recording instructions are embedded in and received with the television programs by being inserted as a binary ASCII-format character string that is assigned specific control functions.

76. (Previously Presented) A method as recited in claim 37, further comprising:

receiving, at the server, a request from a computing system to access a programming homepage;

in response to the request to access the programming homepage, providing the computing system access to the programming homepage, the programming homepage identifying a plurality of television signal providers;

receiving, at the server, a selection of an appropriate one of the plurality of television signal providers; and

in response to the computing system selecting the appropriate television signal provider, and upon receiving a request from the computing system for a corresponding program schedule, the server providing the programming schedule to the computing system.

77. (Previously Presented) A method as recited in claim 37, wherein the recording instructions are downloaded from the server through a vertical blanking interval (VBI) of the television signal.

78. (Previously Presented) A method as recited in claim 37, wherein the recording instructions are downloaded from the server through the Internet.

EVIDENCE APPENDIX

Not applicable.

RELATED PROCEEDINGS APPENDIX

Not applicable.

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